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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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LESEY

FILED 6/22/2002

EXAMINER

RODRIGUEZ, H.

ART UNIT

PAPER NUMBER

1653

7

DATE MAILED:

03/03/02

Attn: Mr. Michael J. Lesey  
Kingsley, Mathews, Olsen & Bear LLP  
1000 Connecticut Avenue, N.W.  
10th Floor  
Washington, D.C. 20004-2660-4990

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 09/068,377	Applicant(s) Lasky et al.
Examiner Hope Robinson	Group Art Unit 1653

Responsive to communication(s) filed on Jan 10, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-22 are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Election/Restriction***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, Claim(s) 1-9, 19 and 20, drawn to an isolated polypeptide classified in class 530, subclass 350.

Group II, Claim(s) 11-14 and 21, drawn to a nucleic acid, host cell and vector, classified in class 536, subclass 23.1 and class 435, subclass 530.1.

Group III, Claim(s) 15-18 and 22, drawn to an antibody, classified in class 530, subclass 387.1+.

Group IV, Claim(s) 10, drawn to an antagonist, classified in class 530, subclass 300+.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The nucleic acids of Invention II are related to the protein of Invention I respectively, by virtue of encoding same. The DNA molecule has utility for

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the recombinant production of the protein in a host cell, recited. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for process other than the production of the protein, such as nucleic acid hybridization assay.

In addition, the proteins of Inventions I are related to the antibodies of Invention III by virtue of being the cognate antigen, necessary for the production of antibodies. Although the protein and antibody are related due to the necessary stearic complementarity of the two, they are distinct Inventions because the protein can be used in another and materially different process from the use for the production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural ligand of the protein (if the protein is itself a receptor), or in assays for the identification of agonists or antagonists of the receptor protein. Furthermore, the protein of Invention I and the antagonist of Invention IV have differing structure and opposing function. Therefore, these products are distinct each from the other.

Further, the nucleic acid of Invention II and the antibody of Invention III are related by virtue of the protein that is encoded by the nucleic acid and necessary for the production of the antibody. However, the nucleic acid itself is not necessary for antibody production and both are wholly different compounds having different compositions and functions. Therefore, these Inventions are patentably distinct.

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Therefore, the search for the nucleic acid does not require search for either the antibody, the polypeptide or antagonist. They are not obvious variants and are different products. Furthermore, 37 CFR 1,475 (b) does not provide for more than 1 product as a combination of invention.

3. A telephone call was made to Ms. Ginger Dreger on 3/6/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 5:00 P.M. (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S. F. Low, can be reached at (703)308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-2742. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope A. Robinson, MS *HR*

Patent Examiner

*Christopher S. F. Low*  
CHRISTOPHER S. F. LOW  
Supervisory Patent Examiner  
PRIMARY EXAMINER  
GROUP 1600